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3711

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/700,425  
Filing Date: November 05, 2003  
Appellant(s): SMITH, DOROTHEA R.

**MAILED**  
**NOV 23 2005**  
**Group 3700**

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Eric LaMorte  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 19, 2005 appealing from the Office action mailed April 15, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: 1) Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins (6,619,661).

2) Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

723,425	Thompson	03-1903
4,417,732	Guill	11-1983
6,708,973	Hall, Jr. et al.	03-2004
6,619,661	Collins	09-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins (6,619,661). Regarding claim 11, Collins discloses a jigsaw puzzle comprising a puzzle framework (40A-40L) that defines an interior and a plurality of puzzle pieces (30A-30D, 20) that are placed within the framework. Collins discloses arithmetic indicia on both the framework and pieces (note Figure 2). The puzzle pieces are seen as being added upon a life event occurring (the user figuring out the proper solution to the arithmetic equation. Regarding the added limitation for the event to be a “life event” that “may or may not occur in a person’s life” such a limitation relates to the meaning and information conveyed by the printed matter. The differences between the printed matter of the instant invention and that of the puzzle of Collins relates to the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences.

Regarding claim 12, the framework comprises a plurality of framework pieces.

Regarding claim 13, the limitation for the pieces to be directed to life principles relates to the indicia and the meaning conveyed by the indicia.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732). Guill discloses a jigsaw puzzle game comprising a framework (11) and a plurality of puzzle pieces (14-23) having indicia thereon. The game includes dice (35) that upon rolling indicate a particular piece of the puzzle to be placed within the framework. The rolling of the dice is seen as a life event. Regarding the added limitation for the event to be a “life event” that “may or may not occur in a person’s life” such a limitation relates to the meaning and information conveyed by the printed matter. The differences between the printed matter of the instant invention and that of the puzzle of Guill relates to the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (723,425). Regarding claim 1, Thompson discloses a puzzle (note Figure 4) comprising a first plurality of pieces (C) that are joined together to create a puzzle assembly. The limitation for the pieces to be directed to different events that may occur in a person’s life relates to the indicia and the meaning conveyed by the indicia. Any differences between the applicant’s game and the game of Thompson reside in the meaning and information conveyed by the printed matter and such differences are not considered patentable differences. See Ex Parte Breslow 192 USPQ 431.

Regarding claims 2-4, Thompson provides a second group of pieces (b, d) that are connected to create a puzzle framework for the first plurality.

Regarding claims 6 and 9, the central pieces have the same configuration.

Regarding claim 7, the central pieces of Thompson present blank spaces about the indicia thereon.

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Regarding claim 8, the different virtues and life principles relate to the indicia and the meaning conveyed thereby. Any differences between the applicant's game and the game of Thompson reside in the meaning and information conveyed by the printed matter and such differences are not considered patentable differences. Note the basis of the rejections set forth in the Office Action mailed September 22, 2004. Regarding the added limitation to claim 1 for the event to be a major event that "may or may not occur" in one's life, this limitation relates to the meaning and information conveyed by the printed matter. The difference between the applicant's game and the game of Thompson reside in the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732). It would have been obvious to one of ordinary skill in the art to form the framework of Guill from a plurality of pieces in order to allow the framework to be separated for more compact storage.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732) in view of Hall, Jr. et al. (6,708,973). Hall, Jr. discloses a puzzle construction including a framework (14) having indicia (18) thereon and a plurality of puzzle pieces placed on the framework. It would have been obvious to one of ordinary skill in the art to place indicia on the framework of Guill in order to indicate the proper placement of the puzzle pieces to the user.

#### **(10) Response to Argument**

**Ground 1:** The rejection of claims 11-13 under 35 U.S.C. 103(a) as being unpatentable over Collins (6,619,661).

The appellant argues that the examiner has erred in his interpretation of what constitutes a “life event” as recited in the claims. The appellant argues that claim 11 states that the life events are recited as being “ birthday, graduation day and wedding day”. The appellant points to the instant specification in an attempt to qualify what is meant by a “life event”.

However, these arguments should not be persuasive. First, it is noted that the features upon which applicant relies (i.e., the particular examples of a life event as set forth in the specification pages 10-12) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, even if one of ordinary skill in the art was to look to the disclosure for examples of what constitutes a “life event”, not only does the specification list “birthdays, a graduation day and a wedding day” but also other occasions such as a first kiss, attending medical school and visiting Hawaii are listed as examples of a “life event”. It is argued that a child learning addition (as taught by Collins) could also be considered to be a “life event”. It is particularly noted that page 11, lines 6-15 detail a puzzle comprising “life events” that are specifically devoted to a doctor. It is further argued that if this constitutes a “life event” then a child learning arithmetic for the first time would also be considered to be a “life event”.

Third, it is noted that the claim uses the language “including” and therefore, the claim does not limit a “life event” to be a “birthday, graduation day and wedding day”. It is also noted that the claim recites “different commonly occurring life events”. This language appears to be entitled to a broader interpretation than the recitation in the specification of “major life events”.

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Therefore, it should follow that any event including solving a math problem would qualify as a life event as it would be an event that would commonly occur during one's life.

Fourth, it is further noted that the language "life event" relates to the information and meaning conveyed by the printed matter. The differences between the printed matter of the instant invention and that of the puzzle of Collins relates to the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences. Both Collins and the instant invention teach the addition of a puzzle piece to the puzzle when a life event occurs (in the case of Collins when a user figures out the solution to the addition equation). The recitation that the piece be added during a birthday or graduation day or wedding day relates to the printed matter itself. Lacking any new and unexpected relationship between the printed matter and the substrate itself, the printed matter does not carry any patentable weight. Attention is directed to *In re Gulack* CAFC 217 USPQ 401 and *Ex parte Breslow* 192 USPQ 431. The "critical question is whether there exists any new and unobvious functional relationship between printed matter and substrate.". Here, a new and unobvious functional relationship between the printed matter and substrate does not exist because the prior art already teaches adding a puzzle piece to the puzzle when a particular life event occurs (figuring out the solution to the addition equation). Patentable novelty cannot be predicated upon printing alone, but must reside in physical structure. *In re Sterling* 21 CCPA 1134, 70 F.2d910. Clearly, the instant invention and the printed matter recited therewith does not meet these standards and thus, does not carry any patentable weight.



**Ground 2:** The rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732).

The appellant argues that the rolling of dice as taught by Guill does not constitute a “life event”. The appellant again points to the instant specification in an attempt to qualify what is meant by a “life event”.

However, these arguments should not be persuasive for essentially the same reasons that are stated above. First, it is noted that the features upon which applicant relies (i.e., the particular examples of a life event as set forth in the specification pages 10-12) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, the specification is silent as to a positive definition for what constitutes a “life event”. The language “life event” should be given its widest possible interpretation and therefore, any event that may or may not occur during a person’s life should be considered to be a “life event”. Further, the specification does not preclude any events that would occur during a person’s life that would not qualify as a “life event”.

Third, as noted above, the claim uses the open language “including”. Further, it is again noted that the specification describes the examples set forth in the specification as “major life events”. Claim 11 only recites “different commonly occurring life events”. As such, the limitation of claim 11 should not be limited to the “major life events” as recited in the specification. Therefore, any event that would occur during one’s life such as rolling a pair of dice should qualify as a “life event”.

Fourth, as noted above, the language “life event” relates to the information and meaning conveyed by the printed matter. The differences between the printed matter of the instant invention and that of the puzzle of Guill relates to the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences. Both Guill and the instant invention teach the addition of a puzzle piece to the puzzle when a life event occurs (in the case of Guill when a user rolls a pair of dice). The recitation that the piece be added during a birthday or graduation day or wedding day relates to the printed matter itself. Lacking any new and unexpected relationship between the printed matter and the substrate itself, the printed matter does not carry any patentable weight.

**Ground 3:** The rejection of claims 1-4 and 6-8 under 35 U.S.C. 103(a) as being unpatentable over Thompson (723,425).

The appellant argues that the reference to Thompson does not disclose puzzle pieces that correspond to different commonly occurring life events such as a birthday, graduation day and wedding day, that may or may not occur in a person’s life. The appellant also argues that Thompson does not disclose the method steps as instantly recited.

However, these arguments should not be persuasive as Figure 4 of Thompson clearly teaches puzzle pieces having indicia that correspond to events that may occur during one’s life. The pieces could indicate when a person meets a man, a boy, a girl or a dog. These are all seen as qualifying as major life events that occur in a person’s life.

Regarding the methodology as recited, lines 4-7 of instant claim 1 are taught by Thompson, in that he clearly provides a plurality of puzzle pieces as shown in Figure 4.

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Regarding lines 8-11, the puzzle pieces of Thompson are joined within the framework.

Regarding the language “correspond to events that have actually occurred in a person’s life to create a puzzle assembly that is a graphical depiction of life events of that person”, this limitation relates to the meaning and information conveyed by the printed matter. It is noted that the claim fails to state how or when the pieces are added to the puzzle and instead merely recites that the pieces are joined together. Thus, the claim merely recites a plurality of puzzle pieces that are joined together. The particular process for adding the pieces is not recited in the claim and instead, the claim merely recites the completely joined puzzle. As such, Thompson provides the plurality of pieces joined together to create a puzzle assembly. The limitation for the indicia to correspond to events that have actually occurred in a person’s life relates to the meaning conveyed by the indicia. Any differences between the appellant’s game and the game of Thompson relate to the meaning and information conveyed by the printed matter and these differences are not considered patentable differences. See *Ex Parte Breslow* 192 USPQ 431. Lacking any new and unexpected relationship between the printed matter and the substrate itself, the printed matter does not carry any patentable weight. *In re Gulack* CAFC 217 USPQ 401.

**Ground 4:** The rejection of claim 12 under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732).

The appellant states that claim 12 is allowable since it depends from claim 11. This should not be persuasive for the reasons stated above regarding the rejection of claim 11.

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**Ground 5:** The rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over Guill (4,417,732) in view of Hall (6,708,973).

The appellant states that claim 13 is allowable since it depends from claim 11. This should not be persuasive for the reasons stated above regarding the rejection of claim 11.

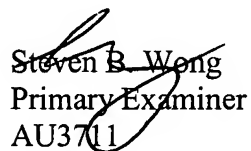
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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

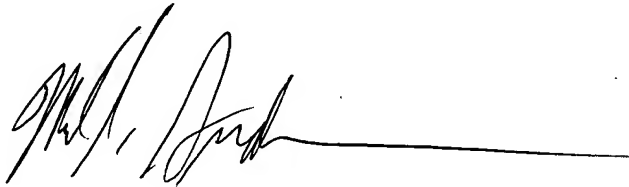
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Steven B. Wong  
Primary Examiner  
AU3711

Conferees:

Mark Graham



Sebastiano Passaniti

